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<b>To: Commissioner for Patents for Examiner Tadesse Hailu Group Art Unit 2173</b>	<b>Facsimile No.: 571/273-8300</b>
<b>From: Carrie Parker Legal Assistant to Vicky Ash</b>	<b>No. of Pages Including Cover Sheet: 7</b>
<b>Message:</b>  <b>Enclosed herewith:</b> <ul style="list-style-type: none"> <li>• Transmittal Document; and</li> <li>• Reply Brief.</li> </ul>	
<b>Re: Application No. 09/921,020 Attorney Docket No: RSW920010065US1</b>	
<b>Date: Monday, September 26, 2005</b>	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Chastain et al.

Serial No.: 09/921,020

Filed: August 2, 2001

For: Method and System for  
Automated Research Using Electronic  
Book Highlights and Notations

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PATENT TRADEMARK OFFICE  
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Group Art Unit: 2173

Examiner: Hailu, Tadesse

Attorney Docket No.: RSW920010065US1

<p><b>Certificate of Transmission Under 37 C.F.R. § 1.8(a)</b></p> <p>I hereby certify this correspondence is being transmitted via facsimile to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, facsimile number (571) 273-8300 on September 26, 2005.</p> <p>By: <u>Carrie Parker</u> Carrie Parker</p>
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**TRANSMITTAL DOCUMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

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SEP 26 2005

Docket No. RSW920010065US1

**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re application of: Chastain et al.**

**Serial No. 09/921,020**

**Filed: August 2, 2001**

# For: Method and System for Automated Research Using Electronic Book Highlights and Notations

**THE UNIVERSITY OF CHICAGO**

**Group Art Unit: 2173**

**Examiner: Hailu, Tadesse**

**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

**Certificate of Transmittal Under 37 C.F.R. § 1.8(a)**

I hereby certify this correspondence is being transmitted via facsimile to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, facsimile number (571) 273-8300 on September 26, 2005.

**By:**

Carrie Parker  
Carrie Parker

**REPLY BRIEF (37 C.F.R. 41.41)**

**This Reply Brief is submitted in response to the Examiner's Answer mailed on July 25, 2005.**

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

(Reply Brief Page 1 of 5)  
Chastain et al. - 09/921,020

**RESPONSE TO EXAMINER'S REMARKS****A. GROUND OF REJECTION (Claims 1-7, 9-16, and 18-21)**

Claims 1-7, 9-16, and 18-21 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Graham et al.* (U.S. Patent Number 6,457,026 B1), hereinafter referred to as *Graham*. This rejection is respectfully traversed.

Claim 1, which is representative of the other rejected independent claims 18, 20, and 21 with regard to similarly recited subject matter, is reproduced below for the convenience of the Board:

1. A method in a data processing system for researching text in an electronic book, the method comprising:
  - receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and
  - automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input.

Appellants continue to submit that *Graham* does not disclose "receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input" as recited in claims 1, 18, 20, and 21; and therefore, does not anticipate claims 1, 18, 20, and 21. *Graham* only discloses portions of the claims and does not teach each and every feature as recited in claims 1, 18, 20, and 21.

In the Examiner's Answer, the Examiner states the following in responding to Appellants' arguments:

*Graham* teaches "receiving user input indicating selection of a set of one or more concepts from said plurality of concepts." (column 9, lines 34-35).

*Graham* further teaches (column 9, lines 36-37, column 3, lines 56-66, column 4, lines 10-28) and illustrates (Figs. 2B, #220, 2C, #224, 2D, #226, etc) the selected text is identified (marked or highlighted) by a user after the electronic document is displayed.

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Examiner's Answer dated July 25, 2005, page 9, lines 3-4 and 9-11.

These portions of *Graham* do not teach or suggest that a user highlights or identifies the selected text by tagging a beginning point and an ending point of any portion of text in the electronic book to form selected text after the electronic book is displayed. To the contrary, *Graham* teaches selecting concepts of interest from a list of concepts maintained in a user profile.

In the Examiner's Answer, the Examiner states the following in responding to Appellants' arguments:

The Appellants further argue, "Graham teaches highlighting keyword in an electronic document based on the contents of a user profile." In contrast to the Appellants' argument, Graham is not limited or bound to a user profile operation, Graham teaches that a user may enable or disable the operation of the user profile updating (Fig. 8, #836 check box, column 7, lines 46-57). Accordingly, it is a choice given to the user, i.e., Graham permits the user to enable or disable the profile operation (via check box 836).

Examiner's Answer dated July 25, 2005, page 10, lines 1-7.

Appellants respectfully disagree with the Examiner's assertions. The "Background Learning" option of *Graham* only enables or disables user profile updating. See *Graham* column 5, lines 45-50. *Graham* teaches that "user profile updating" changes the contents of the user profile to automatically refine the patterns searched for by the pattern identification stage. Further, at column 5, lines 36-37, *Graham* states that the "particular patterns searched for are determined by the contents of user profile file 516." Appellants respectfully submit that *Graham* does not give the user a choice to enable or disable the user profile.

In the Examiner's Answer, the Examiner states the following in responding to Appellants' arguments:

The Appellants further argue, "In *Graham*, the electronic book is highlighted based in response to opening the electronic book." In contrast to the Appellants' argument, as the Examiner points out above, the electronic book is NOT necessarily highlighted based in response to opening the electronic book because it (highlighting) depends on the user profile setup, i.e., enable or disabled profile operation (column 7, lines 46-57). Thus, in response to the opening of electronic document, the displayed texts that are relevant to a user are not necessarily highlighted automatically.

Examiner's Answer dated July 25, 2005, page 10, lines 8-15.

Appellants respectfully disagree with the Examiner's assertions. As discussed above, *Graham* only provides the option of enabling or disabling user profile updating with the

"Background Learning" selection box 836. The cited portions of *Graham* do not disclose an option for disabling the user profile.

In the Examiner's Answer, the Examiner states the following in responding to Appellants' arguments:

The Appellants also argue *Graham*'s web autofetch feature only searches for keywords in a user profile." Again, the Examiner disagrees because all depends on the user profile selected option, if disabled, the web autofetch searches for keyword anywhere in the electronic document (column 7, lines 46-57).

Examiner's Answer dated July 25, 2005, page 10, lines 16-19.

Appellants respectfully disagree with the Examiner's assertions. *Graham*'s web autofetch feature searches an electronic document based on the contents of a user profile and uses a web search tool to look for documents containing keywords or key phrases. *Graham* does not disclose an option or desirability to disable the user profile.

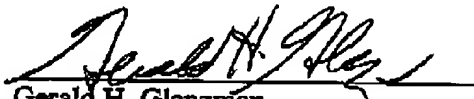
In the Examiner's Answer, the Examiner states the following in responding to Appellants' arguments:

The Appellants also argue "*Graham* provides no ability for a user to select a portion of a displayed electronic book, by tagging a beginning point and an end point, and then initiating a search for an item relevant to the selected portion of text." In contrast to the Appellants' argument, *Graham* teaches selecting by tagging and initiating a search for the selected portion (column 5, lines 32-58, Figs. 9A and 9B).

Examiner's Answer dated July 25, 2005, page 10, line 20, through page 11, line 2.

This portion of *Graham* describes the automatic annotation software architecture of Figure 5. Figures 9A and 9B show an interface for providing user feedback. *Graham* does not teach or suggest the features as recited in claims 1, 18, 20, and 21. *Graham* does not provide the ability for a user to select a beginning point and an ending point of any portion of text in the electronic book after the electronic book is displayed and that this selected portion of text is used to automatically initiate a search for at least one item relevant to this selected portion of text in response to the user selecting this portion of text.

In view of the above, Appellants respectfully submit that claims 1-7, 9-16, and 18-21 define over the prior art of record and that the application is in condition for allowance. Accordingly, Appellants respectfully request the Board of Patent Appeals and Interferences to overturn the rejection of claims 1-7, 9-16, and 18-21 under 35 U.S.C. 102(e).



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